Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JOHN C. BEER,
MARK T. BOWMAN,
GEORGIA A. GIBSON
and JULIETA K. YAMAKAWA

_____

Appeal No. 1997-1199
Application No. 08/309,366

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ON BRIEF

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Before KRASS, BARRETT and LALL, **Administrative Patent Judges**.

LALL, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection[1] of claims 1,

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[1]An amendment after the final rejection was filed (paper
no. 5) and was approved for entry (paper no. 7). As a result,
the rejection under 35 U.S.C. § 112, second paragraph, was
withdrawn.

5 to 14 and 18 to 27, all the pending claims in the

application.

The disclosed invention relates to a computer program,

implemented through a graphical user interface (GUI), that

simplifies the manipulation by a user of attributes of a

computer workstation. An attribute is not only a task

supported by a workstation but also any task that the

workstation will support. The invention separates the

attributes into groups of related attributes. The groups of

attributes are further divided into sets of similar attributes

with each set containing individual attributes. The

workstation retrieves from a data base all the groups of

related attributes and stores those groups in a workstation

memory. Responsive to a user input selecting one group for

display, the workstation displays in a template types pane all

sets of attributes comprising the group of related attributes.

Furthermore, the workstation displays the individual

attributes of one set in a template pane responsive to either

user input or a default selection. With the sets of one group

of related attributes displayed along with the individual

attributes

of one set, the user may easily manipulate the workstation to

perform a desired task. The invention is further illustrated

by the following claim.

1. A method for controlling a computer workstation to display attributes of the computer workstation, comprising   the computer-implemented steps of:

displaying a template area on a display, said template   area comprising a template types pane and a template   pane;

retrieving each group of attributes of the computer workstation from a database;

storing each group of attributes in a workstation memory;

selecting one group from the group of attributes for display;

retrieving sets of attributes from the selected group   of attributes from the workstation memory;

selecting one set from the sets of attributes for display;

retrieving individual attributes of the selected set of   attributes from the workstation memory;

displaying icons representing the sets of attributes in   said template types pane; and

displaying icons representing the individual attributes   of the selected set in said template pane area.

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     The references relied on by the Examiner are:

Sanchez-Frank et al. (Sanchez-Frank) 5,394,522   Feb. 28, 1995
                                     (Filing date, Sep. 13,
1993)

Tyne, Maria (Tyne), <u>OS/2: The Workplace Shell, A User's Guide
and Tutorial for Release 2.0</u>, (Computer Information
Associates, 1992), pp. 277-308.

     Claims 1, 5[2] to 14 and 18 to 27 stand rejected under

35 U.S.C. § 103 over Tyne and Sanchez-Frank.

     Reference is made to Appellants' brief and the Examiner's

answer for their respective positions.

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<u>OPINION</u>

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     We have considered the record before us, and we will

reverse the rejection of claims 1, 5 to 14 and 18 to 27.

     In rejecting claims under 35 U.S.C. § 103, it is

incumbent upon the Examiner to establish a factual basis to

support the legal conclusion of obviousness. <u>See In re Fine</u>,

837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In

so doing, the Examiner is expected to make the factual

determinations set forth in <u>Graham v. John Deere Co.</u>, 383 U.S.

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     [2]Note that in the claims attached to the brief as an
appendix, dependence of claims 5 and 6 should be on claim 1,
and that of claims 18 and 19 on claim 14, <u>see</u> amendment "A"
(paper no. 4).

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1, 17, 148 USPQ 459,

467 (1966), and to provide a reason why one having ordinary

skill in the pertinent art would have been led to modify the

prior art or to combine prior art references to arrive at the

claimed invention. Such reason must stem from some teaching,

suggestion or implication in the prior art as a whole or

knowledge generally available to one having ordinary skill in

the art. <u>Uniroyal, Inc. v. Rudkin-Wiley Corp.</u>, 837 F.2d 1044,

1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); <u>Ashland Oil, Inc.

v. Delta Resins & Refractories, Inc.</u>, 776 F.2d 281, 293, 227

USPQ 657, 664 (Fed. Cir. 1985); <u>ACS Hosp. Sys., Inc. v.

Montefiore Hosp.</u>, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

Cir. 1984). These showings by the Examiner are an essential

part of complying with the burden of presenting a <u>prima</u> <u>facie</u>

case of obviousness. <u>Note</u> <u>In re Oetiker</u>, 977 F.2d 1443, 1445,

24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Furthermore, the Federal Circuit states that "[the] mere

fact that the prior art may be modified in the manner

suggested by the Examiner does not make the modification

obvious unless the prior art suggested the desirability of the

modification." <u>In re Fritch</u>, 972 F.2d 1260, 1266 n.14, 23

USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re

Gordon, 773 F.2d 900, 902,

221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not

be established using hindsight or in view of the teachings or

suggestions of the inventor." Para-Ordnance Mfg., Inc. v. SGS

Importers Int'l, Inc., 73 F.3d 1085, 1087, 37 USPQ 2d 1237,

1239 (Fed. Cir. 1995), citing W. L. Gore & Assocs., v.

Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13

(Fed. Cir. 1983).

We apply the above guidelines to the instant case. We

take the independent claim 1 as an example.

We have reviewed Appellants' arguments (brief, pages 5 to

8) and the Examiner's position (answer, pages 3 to 13)

regarding claim 1. At the outset, we point out that the

claimed step of "displaying icons representing the sets of

attributes in said template types pane" should precede the

claimed step of "selecting one set from the sets of attributes

for display" because the former is necessary for the latter.

A similar problem is found in claim 14. However, this issue

is not before us and we leave it to the Examiner to further

examine it as deemed appropriate.

We have studied the applied two references. We can agree

with the Examiner that the suggested combination could be seen

to show the claimed template area which comprises a template

types pane and a template pane; for example, elements 9 and 8

in Sanchez-Frank are a template types pane and a template

pane, respectively. Furthermore, since claim 1 does not

claim the steps in sequence (the displaying icons step appears

after the selecting step), claim 1 does not exclude the

existence of the template types pane and the template pane

appearing sequentially, rather than simultaneously.

Therefore, we find that Tyne shows a template types pane in

fig. 13.1 and a template pane in fig. 12.11. The two panes

together would comprise the claimed template area, keeping in

mind that the two panes are not required to have any

relationship in time or by any physical boundaries, such as

being adjacent to each other. Thus, the combination of Tyne

and Sanchez-Frank results in the claimed template area.

However, the Examiner's position is not sustainable beyond

that.

We agree with Appellants that neither Sanchez-Frank nor

Tyne show the claimed groups of attributes. At best, we may

agree with the Examiner that Tyne's folder can be considered
as one group (answer, page 3), however, there is no evidence
to support the Examiner's assertion (id. 4) that "it would
have been obvious . . . to organize the attribute sets into
groups." Thus, the suggested combination cannot meet the
steps of claim 1 involving the manipulation of groups, e.g.,
the step of "selecting one group from the group of
attributes."

    Furthermore, we agree with Appellants that Tyne does not
show the claimed workstation attributes (brief, page 5). We
find that in Tyne's fig. 13.1, each of the icons facilitates
the creation of another icon specific to a particular device,
i.e.,
a printer, which may then be dragged to a desired location
(p. 300 of Tyne), and that icon then would not be a part of
the Examiner-called template types pane of fig. 13.1.
Similarly, Sanchez-Frank does not show the claimed attributes
since, as Appellants state, regarding fig. 2 of Sanchez-Frank,
"[n]etwork configuration and protocol definitions provide
controls to manipulate icons in the workspace 8 and are thus
not system attributes." (Id. 7). Thus, we do not sustain the

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obviousness rejection of claim 1, and its dependent claims 5

to 13 over Tyne and Sanchez-Frank.

Next, we take the other independent claim, 14. This is

an apparatus claim corresponding to the method claim 1. Here

too, we make the same observation regarding the order in which

the apparatus elements are recited. The clause containing the

"means for controlling . . . the sets of attributes in said

template types pane" should precede the clause containing the

"means for controlling said processor to select one set from

the sets of attributes for display." Again, we leave it to

the Examiner to employ his examining expertise in dealing with

this issue.

Otherwise, for the same rationale as claim 1 above, we do not

sustain the obviousness rejection of claim 14 and its

dependent claims 18 to 27 over Tyne and Sanchez-Frank.

In conclusion, the Examiner's decision rejecting claims

1,

5 to 14 and 18 to 27 under 35 U.S.C. § 103 is reversed.

REVERSED

	)	
ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	

PSL:hh

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